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Limits of international rights to Sherlock Holmes not so elementary

Sherlock Holmes, the first “consulting detective,” has enjoyed a renaissance in the past several years. On American television, he is a modern-day recovering drug addict (“Elementary”). On British TV, he is an obsessively texting, social media-connected modern man (“Sherlock”). In the movies, as portrayed by Robert Downey, he is a Victorian lecher and brawler.

The fan in me loves these various reboots of a character I have enjoyed since childhood. The writer in me wonders how Arthur Conan Doyle (Holmes’ creator) would react to these distinctive variations on his serious-minded, crime scene investigator. The lawyer in me is impressed that Conan Doyle’s nearly 127-year-old creation is still earning licensing fees.

In the United States, most of those fees may be coming to an end. Around the globe, the freely copyable nature of Sherlock Holmes is indeed far from “elementary.”

There is little doubt that, even in the most copyright-protective countries, Holmes’ first appearance in 1897 in “A Study in Scarlet” would now be in the public domain. But Holmes appeared in 56 more stories and three more novels between 1897 and 1927.

Like most characters in a series, over the course of these stories, the character of Sherlock Holmes changed. Readers met the archvillain Professor Moriarty, discovered Holmes the beekeeper and potential vampire slayer and, over time, Holmes the irascible became a kinder, gentler man.

With the exception of the introduction of Professor Moriarty, all of these changes occurred in works that remain subject to copyright protection in the United States.

There is no question that well-defined characters are subject to copyright protection globally. In the United States, protection is generally provided for characters that are “well-delineated.” In determining the delineation of a character, U.S. courts consider

various factors, including the character’s background, abilities, appearance and personality traits.

Sherlock Holmes was expressly mentioned by the court in a similar case where fictional characters and branding intersect as an example of a well-delineated character (*Metro-Goldwyn Mayer Inc. v. American Honda Motor Co.*, 900 F. Supp. 1287 (C.D. Cal. 1995)).

In July, in a German case involving the unauthorized reproduction of the Pippi Longstocking character in advertisements for a supermarket chain, the German Federal Court of Justice (Der Bundesgerichtshof) used a “unique personality plus” test to establish the copyrightable nature of Pippi (IZR52/13, July 17, 2013).

The court held that copyright protection attached to characters that were a distinctive combination of “external appearance, personality, skills and typical behavior patterns.” It considered not merely Pippi’s distinctive appearance, but also her background and personality traits, including her fearlessness, her disrespect for authority and her imaginative-ness.

For characters that are strongly delineated in both background and personality, copyright protection is generally available internationally. The true problem arises in predicting where the boundary lies between permissible and impermissible appropriation of protected expression.

In *Klinger v. Conan Doyle Estate Ltd.*, the U.S. District Court for the Northern District of Illinois applied an “increments of expression” test to define the continuing copyright boundaries of Holmes’ largely public domain character. (13 C1226, Dec. 23, 2013). These “increments” were identified as “Dr. Watson’s second wife and his athletic background, as well as Sherlock Holmes’ retirement.” These elements appear to be event-driven developments.

By contrast, in the Pippi Longstocking case, the German court used an “external features plus test” to establish the boundaries of acceptable appropriation of a copyrighted character. Because the

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defendant had only copied Pippi’s external features — her freckles, red pigtails and funny dress, it had not copied the character because it had not copied her personality.

This focus on the personality and features of a character is distinctly different from the events focus of *Klinger*. Both cases underscore the currently unpredictable nature of copyright protection for literary characters.

Even more problematic for adopters of the public domain Sherlock Holmes are the international limitations that may be imposed under moral rights doctrines. As the creators of an unauthorized serial to Victor Hugo’s “Les Misérables” discovered, moral rights protection can survive even when the works enter the public domain.

Moral rights internationally give authors the right to prevent unauthorized alterations to their works that are harmful to their reputation. This “right of integrity” survives any transfer of copyright. In some countries, such as France, it lasts in perpetuity. (Article L-121-1, French Intellectual Property Code). Unfortunately for Victor Hugo’s estate, even though the French court upheld the claim, it only awarded a single euro in damages.

Creators of new Holmes’ works should also beware of possible

trademark based attacks. As Disney and other producers of comics and other graphic works have discovered, copyrighted works may enter the public domain, but a trademarked version of the character can last forever.

Admittedly, trademark law does not prohibit the creation and distribution of “A Study in Scarlet” or any other work using Holmes as a character. But how the work is publicized, including the use of references to Conan Doyle or use of a deerstalker cap (or other Holmesian accoutrements), may give rise to allegations of trademark infringement.

Within days of the *Klinger* decision, a lawsuit was filed in Britain accusing the BBC of trademark violations arising from the “Sherlock” series. Although the U.S. Supreme Court rejected any moral rights type claims under the *Lanham Act* in *Dastar v. Twentieth Century Fox*, 539 US 23 (2003), other countries do not apply a similar restriction.

Although the global rollout of new unlicensed Holmes stories may not be “elementary,” there are several steps writers and fans can take to minimize these risks.

First, the exhibits attached to the *Klinger* opinion give creators a good laundry list of characters and background developments that are in the public domain. They also list the 10 books that are still protectable, including “The Sussex Vampire.” (Fans hoping for “Sherlock Holmes: Vampire Hunter” will just have to wait.)

Second, although references to Sherlock Holmes and Arthur Conan Doyle are permissible, they should not lead readers to believe the new works are authorized by the Conan Doyle estate. Adding a disclaimer of any such affiliation would certainly help.

Finally, writers should create their own Holmes story. The more original the Sherlock character and his adventures are, the more likely the writer will avoid any copyright pitfalls.

And, of course, there are always the many untapped adventures of Dr. Watson for intrepid writers to pursue.